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Filed May 22, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MERI EDELMAN,
AVIHAI PERL, MOSHE FLAISHMAN, and
AMNON BLUMENTHAL,
Junior Party

(Application 09/529,172),

v.

ANNE-MARIE STOMP, and
NIRMALA RAJBHANDARI,
Senior Party
(Patent 6,040,498).

MAILED

MAY 22 2006

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 105,261

Before Delmendo, Lane, and Moore, Administrative Patent Judges.

Lane, Administrative Patent Judge.

Decision - Rehearing - Bd.R. 125 (c))

I. Introduction

The interference was redeclared and final judgment was entered against Edelman on 11 April 2006. (Papers 48 and 49, respectively). Edelman has filed a request for reconsideration of the redeclaration and the final judgment. (Paper 50,

1 Request). The Request is GRANTED.

2 II. Background

3 The interference was redeclared after Edelman's unopposed Motion 1 (Paper 44,
4 Motion) was granted. (Decision, Paper 47). In Motion 1, Edelman sought to substitute
5 proposed Count 2 for Count 1. Count 2 differs from Count 1 in that Count 2 does not
6 contain Edelman claim 19, while Count 1 does.

7 At one point in its Motion, Edelman asked that claims 19, 21, and 22 be
8 designated as not corresponding to Count 2 (Motion at 19) while at other points in the
9 Motion, Edelman included claims 21 and 22 in the list of claims to be designated as
10 corresponding to Count 2 (e.g., Motion at 1 and 19).

11 In the redeclaration of the interference, claims 21 and 22 were designated as
12 corresponding to Count 2 (Paper 48 at 2) and final judgment was entered against
13 Stomp as to claims 21 and 22. (Paper 49 at 2). Edelman asks that we reconsider the
14 redeclaration to the extent that claims 21 and 22 were designated as corresponding to
15 Count 2 and the final judgment to the extent that claims 21 and 22 were indicated to be
16 unpatentable to Edelman. (Request at 5-6).

17 Edelman states that "[t]his request for reconsideration merely requests correction
18 of an obvious inadvertent error in Edelman's Motion 1." (Request at 4). According to
19 Edelman, "[t]he party Stomp agrees that the inclusion of claims 21 and 22 in the list of
20 claims corresponding to Count 2 was inadvertent and obviously should have been
21 designated as not corresponding to Count 2 for the same reasons as ruled for
22 independent claim 19, and has agreed not to oppose this motion." (Request at 4).

1 III. Discussion

2 Claim 19 is as follows:

3 A method for the genetic transformation of a plant comprising;
4 cutting the plant into particles of a size such that they still contain
5 undamaged meristematic tissue capable of developing into full plants;
6 incubating said particles with *Agrobacterium* cells containing
7 transforming DNA molecules, whereby said transforming DNA is
8 introduced into meristematic cells in said particles; and
9 producing transformed plans from the transformed meristematic
10 tissue.
11

12 Claims 21 and 22 depend from claim 19.

13 Claim 21 reads as follows:

14 A method according to claim 19, wherein the particles have diameters, the
15 average of which is above 150 μm .
16

17 Claim 22 reads as follows:

18 A method according to claim 21, wherein the particles have diameters, the
19 average of which is about 150 μm to about 750 μm .
20

21 In our Decision, we noted that “[a] claim is properly designated as corresponding
22 to a count if the count, taken as prior art, would have anticipated or rendered obvious
23 the subject matter of the claim.” Bd.R. 207(b)(2). We determined that Edelman had
24 shown that Count 2 would not anticipate or render obvious claim 19. (Decision at 15).
25 Accordingly, it follows that Count 2 would not anticipate or render obvious claims 21 and
26 22 which are more limited in scope than claim 19.

1
2 IV. Order

3 Upon consideration of the record and for reasons given, it is

4 ORDERED that the Stomp request for reconsideration (Paper 50) is
5 GRANTED;

6 FURTHER ORDERED that the final judgment entered 11 April 2006 is
7 VACATED;

8 FURTHER ORDERED that the interference will be redeclared to reflect
9 that claims 21 and 22 do not correspond to Count 2;

10 FURTHER ORDERED that final judgment will be entered against Stomp
11 as to the claims designated as corresponding to Count 2 after the interference is
12 redeclared.
13
14

15	/Romulo H. Delmendo/)	
16	Administrative Patent Judge)	
17)	BOARD OF PATENT
18	/Sally Gardner Lane/)	APPEALS AND
19	Administrative Patent Judge)	INTERFERENCES
20)	
21	/James T. Moore/)	
22	Administrative Patent Judge)	
23)	

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